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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,098	12/04/2001	Tonya Torri	CS11027	9467

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EXAMINER
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SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/006,098	<b>Applicant(s)</b> TORRI ET AL.	
	<b>Examiner</b> Matthew C. Sams	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/21/2006 has been entered.

3. Claims 19 and 20 have been withdrawn.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being obvious over Janninck et al. (US-6,768,899 hereafter, Janninck).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1 Janninck teaches a handheld wireless device comprising two housing portions, connected together in a manner that the second housing portion rotates in a planar motion about the connection to the first housing portion. (Fig. 2 [260, 210 and 270]) Janninck teaches of a closed position that is when the second housing surface is adjacent to the first housing surface. (Fig. 1 [100]) Janninck teaches an open position where the first surface and second surface are exposed. (Fig. 2 [100]) Janninck teaches a keypad (Fig. 2 [232 & 234]) on the second surface of the second housing portion (Col. 3 lines 22-35) that is exposed in the open position (Fig. 2) and concealed between the first housing portion and the second housing portion in the closed position. (Fig. 1) Janninck teaches a user interface on the second surface that

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is exposed when the second housing portion is in the open position and concealed when the second portion is in the closed position (Fig. 2 [230]), but differs from the claimed invention by not explicitly reciting a user interface on the first surface that is exposed when the device is in the open position and concealed when the device is in the closed position.

However, Janninck teaches a user interface that is concealed when in the closed position (Fig. 2 [234]) and a user interface that is exposed at all times on the first housing portion. (Fig. 2 [160]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to conceal the user interface (Fig. 2 [160]) on the first surface of the first housing portion since the user interface would be protected from being inadvertently activated at an unwanted time.

Regarding claim 2, Janninck teaches a user interface that includes a set of volume buttons. (Col. 3 lines 27-35)

Regarding claim 3, Janninck teaches a first housing portion that includes a first rotating portion and an extended portion. (Fig. 4 [250]) Janninck teaches a second housing portion that includes a second rotating portion and an extended portion. (Fig. 4 [120])

Regarding claim 4, Janninck teaches a second extended portion that extends over the user interface when in the closed position. (Fig. 1 & Fig. 2)

Regarding claim 5, Janninck teaches a first housing portion and second housing portion are substantially the same size. (Fig. 1 [100] and Fig. 4 [120 & 250])

Regarding claim 6, Janninck teaches an open position that has a 180° displacement between the first and second housing portions. (Fig. 2)

Regarding claim 7, Janninck teaches a user interface located at the natural resting place of an index finger on the second housing portion, which the applicant defines as the natural resting place. (Col. 3 lines 22-35)

Regarding claim 8, the limitations of claim 8 are rejected as the same reason set forth in claim 7.

Regarding claim 9, Janninck teaches a handheld wireless device comprising two housing portions, connected together in a manner that the second housing portion rotates in a planar motion about the connection to the first housing portion, each housing device with an inner and outer surface. (Fig. 2 [260, 210 and 270], Fig. 3 and Fig. 4) Janninck teaches a closed position when the second housing inner surface is adjacent to the first housing inner surface. (Fig. 1 [100]) Janninck teaches an open position where the first inner surface and second inner surface are exposed, with 180° separating the open position from the closed position. (Fig. 2 [100]) Janninck teaches a user interface on the first inner surface that is exposed when the second housing portion is in the open position and concealed when the second portion is in the closed position. (Fig. 2 [234]) Janninck teaches keypad (Fig. 2 [232]) on the inner surface of the second housing portion (Col. 3 lines 22-35) that is exposed in the open position (Fig. 2) and concealed between the first housing portion and the second housing portion in the closed position. (Fig. 1) Janninck teaches a user interface on the second surface that is exposed when the second housing portion is in the open position and concealed

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when the second portion is in the closed position (Fig. 2 [230]), but differs from the claimed invention by not explicitly reciting a user interface on the first surface that is exposed when the device is in the open position and concealed when the device is in the closed position.

However, Janninck teaches a user interface that is concealed when in the closed position (Fig. 2 [234]) and a user interface that is exposed at all times on the first housing portion. (Fig. 2 [160]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to conceal the user interface (Fig. 2 [160]) on the first surface of the first housing portion since the user interface would be protected from being inadvertently activated at an unwanted time.

Regarding claim 12, Janninck teaches buttons for increasing and decreasing the volume. (Col. 3 line 58 through Col. 4 line 7)

Regarding claim 13, the limitations of claim 13 are rejected as the same reason set forth in claim 7.

Regarding claim 14, the limitations of claim 14 are rejected as the same reason set forth in claim 9.

Regarding claim 15, Janninck teaches a user interface with a first volume button and a second volume button. (Col. 3 lines 22-35)

Regarding claim 16, Janninck teaches a second housing portion with two positions, one planarly adjacent to the first housing portion and a second position where the second housing portion is only partially planarly adjacent to the first housing portion. (Fig. 1 & Fig. 2)

Regarding claim 17, Janninck teaches a user interface on the inner surface of the second housing that is inaccessible when adjacent to the first surface and accessible to a user's index finger when the second housing portion is in the open position. (Fig. 1, Fig. 2 and Col. 3 lines 22-35)

Regarding claim 18, Janninck teaches an open position and a closed position. (Fig. 1 & Fig. 2)

### ***Response to Arguments***

6. Applicant's arguments filed 2/21/2006 have been fully considered but they are not persuasive.

Regarding claims 1, 9 and 14, it would have been obvious to one of ordinary skill in the art to be motivated to conceal the selection button (Fig. 1 [160]) on the first surface of the first housing portion (e.g. exposed when in the open position and concealed in the closed position) to keep the selection button from being activated inadvertently when being stored inside a user's pocket.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCS  
5/08/2006

  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER